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IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

No. 322

ALEXANDER T. SPERRY, *Petitioner*

vs.

STATE OF FLORIDA, ex. rel THE FLORIDA BAR,
Respondent

BRIEF OF AMICUS CURIAE

The Florida Patent Law Association
In Support of
Petition for Writ of Certiorari

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By consent of the Petitioner and Respondent, the Florida Patent Law Association, which consists of persons, all registered to practice before the United States Patent Office, some of whom are members of the Florida Bar, some of whom are members of Bars of other States, and some of whom are not members of any Bar, file this Brief as Amicus Curiae, in support of the Petition for Writ of Certiorari.

Interest of Amicus Curiae

The amicus curiae have a vital interest in this case, since their right to continue practice in Florida and elsewhere is threatened by the decision of the Florida Court, which denies to persons, registered before the United States Patent Office, the right to practice before the United States Patent Office from an office in Florida. We have read the Petition for the Petitioner filed herein, and concur therein. We also respectfully call the attention of the Court to the following additional facts and arguments:

ARGUMENT

It should be noted that the essential issue in this case is the right to practice before the *United States Patent Office*, with an office in Florida, *NOT* before any Court or Tribunal in the State of Florida.

1. The Decision Below is in Conflict with Constitutional Provisions and Decisions in Other States.

Article I, Section 8, of the Constitution of the United States, states:

> "The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

This is a perfectly clear statement in the Constitution which would not seem to be subject to interpretation. This

power has been delegated by Congress to the Commissioner of Patents. The Federal Government has for 175 years had exclusive control of patents and copyrights. The first Patent Act was passed in 1790. The Patent Office under the Commissioner was set up in 1836 and the latest revision of the Patent Laws was in 1952, but it is basically the same law as that of 1836.

The United States Code, Section 31 of Title 35 states:

> "The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of *agents*, attorneys, *or other persons* representing applicants or other parties before the Patent Office, and may require them before being recognized as representatives of applicants or other persons, to show that they are of good moral character, and reputation, and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office. July 19, 1952, C.950. 66 Stat. 795" (Emphasis added).

Note the specific mention of "agents" or "other persons" which shows that Congress contemplated admission of non-members of the Bar.

For a State to interfere with this control either directly or indirectly is a gross encroachment by the State in an activity reserved to the Federal Government and an attempt to nullify an act of Congress.

The Florida decision is in direct conflict with other State Court cases cited in Petitioner's Brief and particularly with the Ohio case of Battelle Memorial Institute vs. Green, et al., 133 U.S.P.Q. 49, (1962), cited in Petitioner's Brief. The Ohio Court correctly stated that:

> ". . . . the requirements for admission to practice before the Patent Office make it clear that *skill in engineering and scientific matters and familiarity with patent procedures* are as necessary as skill in legal matters, and persons who are not attorneys may qualify for admission as agents . . . ."
> (Emphasis added)

And further that . . . .

> "Were the courts of each state to control practice before the United States Patent Office, thus usurping a right to control that which they cannot authorize in the first instance, by considering it to constitute the practice of law within their state; then the courts of the 50 states, by ignoring the provisions of Article VI of the United States Constitution, supra, could render the provisions of Congress in regard to practice before the Patent Office as enacted under the provisions of Article I, Section 8, of the United States Constitution, supra, a nullity.
>
> * * * * *
>
> "For the reasons set forth, we conclude that control of practice before the U.S. Patent Office is

a superior right vested exclusively by the United States Constitution and by acts of Congress in the Commissioner of Patents, subject to appeal to the federal courts, and the state courts, by virtue of Article VI of the United States Constitution, are bound thereby and precluded from interfering."

2. Patent Office Practice requires, primarily, extensive scientific and engineering knowledge.

In the case at Bar, the Florida Court and the Florida Bar, represented by five highly capable and well qualified members of the Bar, demonstrate a laudable desire to protect the public and the Bar, but also a misunderstanding of the true facts of what practice before the United States Patent Office entails. The task of understanding an invention and properly describing it in an application for Letters Patent, and the prosecution through the Patent Office comprises at least 80% technical, engineering and scientific skill and knowledge, and knowledge of the Rules of Practice of the United States Patent Office, and perhaps 20% of general legal knowledge.

Two important requirements of Patent Office practice are, *first*, expressing an opinion as to the patentability of an alleged invention by studying the technical data contained in the prior art patents and *secondly*, writing down on paper with accompanying technical drawings a description of what the invention actually is, and distinguishing it from the prior art.

One of the most difficult parts of the proceedure is for the patent attorney to find out by personal interview

from the inventor, who may be either untutored or a graduate engineer and scientist, exactly what his invention is. This is difficult to do unless the patent attorney is also possessed of adequate technical, engineering, and scientific background to understand the invention and communicate with the inventor. It is analogous to an attempt to extract from a client the facts on which a possible law suit is to be based. This is nearly impossible to do by correspondence between a client and an attorney who are widely separated geographically.

Another important skill required to practice before the Patent Office, is a thorough knowledge of the Rules of Practice of the United States Patent Office, some three hundred and fifty two in number.

3. **The Florida decision denies to its citizens rights enjoyed by citizens of other States.**

The effect of the Florida Court's decision would be to force the petitioner to move out of the State, in order to perform those acts which Congress, acting under the United States Constitution has authorized him to perform and which he may perform in other states. The result would be that Florida inventors would either have to go to Washington, D. C., or send their inventions to petitioner, by mail. If an inventor engaged a member of the Florida Bar, who is not a patent attorney, as is generally the case, that Florida attorney would probably forward the case to a patent attorney in Washington, D. C., or some other state. The result would be to impose an almost impossible communications barrier between the inventor and the patent attorney and greatly increase the expense of obtaining a patent by an inventor. Such a situation is

both unjust and unwarranted. Theoretically the inventor or a Florida general attorney could go to a Florida patent attorney who is a member of the Florida Bar. However, there are a totally inadequate number of such Florida patent attorneys.

Thus, the real effect of the decision is not to protect the public but to require the public to attempt to communicate by correspondence with a patent attorney in Washington, either directly, or through a member of the Florida Bar, who is not an engineer and not scientifically trained. The result would be a great deal of confusion and inefficiency and what is more important, the patent, if obtained, would probably not reflect the actual invention. It might reduce the scope of the patent to which the inventor is entitled, or result in encroachment on the prior art to the extent of invalidating the patent.

4. The Question Presented Seriously Affects our National Research and Defense Effort.

Another unintended effect of the Florida Court's decision will be the restraint upon movements of research laboratories which frequently carry with them registered patent attorneys. A patent department of a large national corporation would be loath to send one of its members, who might be a member of the Bar in another State, into Florida to speak to a scientist because of the decision of the Florida Court. Such a hinderance to the movement and activities of registered patent attorneys and research would, in he long run, have a serious adverse effect not only on the State of Florida, but the entire country as well, by limiting the operation of registered patent agents or patent attorneys who are not members of a particular

State Bar. Thus, for example, a registered patent attorney who is a member of the Bar of the State of New York, Illinois, or California, and one who might be a highly trained specialist in space vehicles, or electronic guidance systems, and employed by a corporation patent department, in one of the said States could not, if transferred to the corporations' Cape Canaveral, Florida Branch Research Plant, prepare and file patent applications or analyze patents in Florida.

5. The Following Facts are also Pertinent to the Case.

Advertising by a registered Patent Attorney or Agent is strictly prohibited as unprofessional conduct by Rule 345 of the Patent Office of August 27, 1957 (22 Federal Register 6898), and is punishable, by the Commissioner of Patents, by suspension or disbarment from practice before the Patent Office. This Rule implements Section 32, entitled "Suspension or Exclusion from Practise", of U.S.C. Title 35. This disciplinary control is strictly enforced.

Another fact pertinent here is that to become a Patent Attorney one must now *either* serve on the Corps of Examiners of the United States Patent Office for four years, which requires an engineering or scientific education, *or* take an examination which is both technical and also covers the Rules of Practice of the United States Patent Office. This examination is so exacting that a private organization, the Practising Law Institute of New York, is now offering a "quiz" course of 36 hours duration to prepare for it. This brings out the fact that admission to practice before the United States Patent Office is not mere formality, but contains very rigorous requirements.

SUMMARY

1. Only practice before the United States Patent Office and *not* before any court or tribunal of the State of Florida is here involved.

2. The decision clearly violates Article I, Section 8 of the Constitution, and is in conflict with decisions in other States. It is an attempt by a State to encroach on a purely Federal matter and to nullify an act of Congress.

3. The Court below, and the Florida Bar, have misunderstood the highly technical nature of Patent Office practice.

4. The real effect of the Florida Court's decision would be not to protect the public and the Bar, but to retard the national research and development effort, and to seriously impede the public and the Bar in their efforts to obtain valid patents.

CONCLUSION

The amicus curiae respectfully urges that the petition for a Writ of Certiorari be granted and the decision of the Florida Supreme Court reviewed, since a unique question of vital importance to the public, to the Bar, and affecting all of the citizens of the United States, is in-

volved. This erroneous interpretation of the United States Constitution, however well meaning, should be corrected.

Dated at Miami, Florida, this 10th day of October, 1962.

Respectfully submitted,

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